Section III:

AMENDMENT UNDER 37 CFR §1.121 to the DRAWINGS

No amendments or changes to the Drawings are proposed.

Section IV:

AMENDMENT UNDER 37 CFR §1.121

REMARKS

Change of Examiner, Rejection of Previously Allowed Claim

This application has apparently been transferred from the previous examiner, Ramya Ananthanarayanan, to a second examiner, Kaveh Abrishamkar. In the previous Office Action, Claim 3 was indicated as allowable. In response to this indication, applicant amended the steps, elements or limitations of Claim 3 into the independent claims of the application, and amended claim 3 to cover a different aspect of the invention.

In the present Office Action, the second examiner has not explained why a new search was required, and why full faith and credit was not afforded to the previous examiner's search and decision, per guidelines at MPEP 706.04.

In particular, it is unusual that a second examiner would issue rejections under 35 U.S.C. §101, when a previous examiner had not issued such a rejection. Additionally, it is unusual to employ completely new art in a rejection of a claim which was previously indicated as allowable, whereas the first search is normally comprehensive of the art as covered by the scope of the claims, as well as the scope of the disclosure which the examiner deems may be claimed.

Therefore, the issuance of new rejections under 35 U.S.C. §101, and new rejections over newly cited art under 35 U.S.C. §102, may constitute improperly taking an entirely new approach, improperly attempting to reorient the point of view of a previous examiner, and/or improperly making a new search in the mere hope of finding something. *Amgen, Inv. V. Hoechst Marion Roussel, Inc.*, 126 F. Supp. 2d 69, 139, 57 USPQ2d 1449, 1499 - 50 (D. Mass. 2001), as cited in MPEP 706.04.

Applicant reserves the right to petition or Appeal this basis. Applicant's reply contained herein addressing the substance of the newly cited art should not be construed as a waiver of a right to Appeal or Petition on this basis.

Rejections under 35 U.S.C. §101

In the Office Action, claims 1 - 8 and 17 - 24 were rejected under 35 U.S.C. §101 for failing to delineate a method which is embodied in a tangible medium, and failing to claim a data structure embodied in a tangible medium, respectively.

With respect to Claims 1 - 8, examiner has not provided citation of an authority which requires a method invention to be embodied in a tangible medium. However, there is authority in case law for the statutory patentability of methods which accomplish a tangible or concrete result:

> The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02.

Claims 1 - 8 clearly operate on a "useful" and "concrete" thing (e.g. the access control policy), and produce a "useful", "tangible" result (e.g. the authorization of a computer system to perform an action which otherwise would be prohibited).

With respect to Claims 17 - 24, the present amendment renders the claimed material as statutorily patentable as the data structures are embodied or recorded in a computer readable medium. Additionally, Claim 17 recites a functional element, the "permission list evaluator", as part of a system, which may be software, as presumed in the rationale for the rejection, or may alternatively be a device, such as an application specific integrated circuit.

No new matter has been added by this amendment. Applicant requests withdrawal of the rejections, and allowance of claims 1 - 8 and 17 - 24.

Rejections under 35 U.S.C. §102(e)

Rejections of Claims 1, 4, 9, 12, 17 and 20 Over Icken

In the Office Action, claims 1 - 24 have been rejected under 35 U.S.C. §102(e) for lack of novelty as being anticipated by U.S. Patent Number 6,816,906 to Icken (hereinafter "Icken"). Claims 1, 4, 9, 12, 17 and 20 are independent claims.

As previously specified in Claim 3, a step, element or limitation of our invention which allows reuse of a finite number action indicators in association with a plurality of action group

tags or action group containers, wherein each action indicator combined with the group tag or container can be assigned a unique permission, was amended into the independent claims 1, 4, 9, 12, 17 and 20 in applicant's previous amendment. In this manner, the number of permissions which can be controlled is expanded to beyond just the number of action indicators, but to an upper limit equal to the product of the number of allowable action indicators and the number of action tags or action containers.

By "action indicators", we mean the permission indicators for actions such as "attach", "add", "connect", "delete", etc., as discussed in paragraphs [0065] - [0066], Table 3, and paragraph [0071]. These are indicating allowable actions, not users. A user's identity or identifier is contained elsewhere in the access control list, but is not the same as the action indicators.

By "action group container" and "action group tags", we mean a group of action indicators, not a group of users. Action indicators which are all related to each other for some common reason or purpose, such as performing a system backup, can be grouped under a single action group tag, or contained in an action group container. These are not tags for groups of users, or containers for groups of users, as discussed in our paragraphs [0070] - [0078].

To extend the ability of defining permitted actions within the groups of actions, we have disclosed and claimed the ability to "re-use" action indicators between multiple groups. For example, in systems without our invention, an action indicator of "r" might always permit a "read" action. But, with use of our invention, the action indicator "r" might permit a "read" action in an action group called "file_check_out", but the same action "r" might permit a "rewind" operation in an action group called "tape_operations", as discussed in our paragraphs [0070] - [0073].

As such, even with a fairly limited number of distinct action indicators, such as the 18 pre-defined action indicators of the embodiment which operates in cooperation with Tivoli's Policy Director, many more actions than 18 can be controlled based upon redefining each action indicator's meaning within multiple action group tags or multiple action group containers.

In the Office Action, it was reasoned that Icken teaches our steps, elements or limitations of providing groups of "action indicators" within "action groups" or "action containers", wherein the action indicators are "reused" among action groups or action containers, at the following passage:

The foregoing user assignment as shown in the table 14 in FIG. 1 may be for any number of **users U_1, U_2, - - - U_x**, who may be assigned different roles imparting access to the authoring system 10, **which may be used to group users by related functionality**, as defined by attributes, logic and values. Thus, the active user table 14 which identifies the Userid, Active Flag and Role, leads to boolean logic to test a given value against a corresponding Attribute value in the content, display component and/or other authoring system constituents. The **role assigned to a particular user** may be predetermined by the data supplied to the access control engine 12 by the build mechanism 18, so as to impart to the user specific types of authorities, such as being capable of only reading the author material, or editing the author material at any particular site or sites.

Moreover, by way of example, a **user or users or may be imparted further roles** enabling him or them to access author materials at different geographic locations; for instance, a user in New York may be empowered to gain access to author material in New York, Chicago or Los Angeles. Moreover, the user may possibly be empowered to only "read" material in Chicago and Los Angeles, while being able to "edit" the author material in New York, although numerous permutations and different attributes may be assigned to any particular user or users at any specific location or locations in accordance with data supplied to the active user table 14 from the access control engine 12.
(Col. 4, lines 33 - 55, emphasis added)

This passage is silent as to grouping actions, but instead appears to group **users**, denoted by a capital letter "U" in the list **U_1, U_2, - - - U_x** into various "roles", such as "editor", "author", "reader", etc. As such, Icken appears to be a role-based authorization engine (col. 1 lines 52 - 67; col. 2 lines 3 - 11 and lines 29 - 31; and col. 3 lines 8 - 10). Icken explicitly defines a "role" as:

c) Role--is **utilized to group users** by related functionality, which is implemented by attributes, logic and values, as defined hereinbelow
(Col. 2, lines 29 - 31, emphasis added)

For these reasons, to interpret Icken as disclosing our "action groups" and "action containers" in the manner proposed in the rationale for the rejections would be improper importation of our definitions into the cited art, whereas Icken discloses "groups of users" as "roles", and not "groups of actions" as "action groups" or actions in "action group containers".

Applicant hereby requests entry of the present amendment, and allowance of independent claims 1, 4, 9, 12, 17 and 20.

Rejections of Claims 2 - 3, 5 - 8, 10 - 11, 13 - 16, 18 - 19, and 21 - 24 Over Icken

In the Office Actions, claims 2 - 3, 5 - 8, 10 - 11, 13 - 16, 18 - 19, and 21 - 24 were rejected under 35 U.S.C. §102(e) for lack of novelty as being anticipated by Icken, with the rationale of the rejections of claims 1, 4, 9, 12, 17 and 20 being applied. Claims 2 - 3 depend from Claim 1, claims 5 - 8 depend from claim 4, claims 10 - 11 depend from claim 9, claims 13 - 16 depend from claim 12, claims 18 - 19 depend from claim 17, and claims 21 - 24 depend from claim 20.

For the foregoing reasons, claims 2 - 3, 5 - 8, 10 - 11, 13 - 16, 18 - 19, and 21 - 24 recite elements, steps, and limitations not taught by Icken. Applicant requests entry of the amendment, and allowance of claims 2 - 3, 5 - 8, 10 - 11, 13 - 16, 18 - 19, and 21 - 24.

Common Assignment of Icken and Present Application

Applicant notes that the present application and the cited Icken patent were commonly assigned, or were subject to an obligation to commonly assign, at the time the invention of the present invention was made. Thus, Icken is not available as prior art in a potential obviousness rejection under 35 U.S.C. §102(e)/§103, per 35 U.S.C. 103(c).

For these reasons, applicant requests entry of the amendment and allowance of all claims.

Respectfully,

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